Docket No. CA920000074US1 (7161-208U) **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Customer Number: 46320
James LAU	:	Confirmation Number: 2828
Application No.: 10/015,378	:	Group Art Unit: 2134
Filed: December 12, 2001	:	Examiner: M. Simitoski

For: METHODS, SYSTEMS, SIGNALS AND MEDIA FOR ENCOURAGING USERS OF COMPUTER READABLE CONTENT TO REGISTER

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed December 27, 2006, wherein Appellant appeals from the Examiner's rejection of claims 1-13, 15-22, 29, and 31-35.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on December 12, 2001, at Reel 012381, Frame 0403.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-13, 15-29, and 31-39 are pending in this Application. Of those, claims 1-13, 15-22, 29, and 31-35 are four-times rejected in this Application, and claims 23 and 24 have been indicated as being allowable. Claims 25-28 and 36-39 have been withdrawn pursuant to the provisions of 37 C.F.R. § 1.142(b). Claims 14 and 30 have been cancelled. It is from the multiple rejections of claims 1-13, 15-22, 29, and 31-35 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Fourth Office Action dated September 27, 2006 (hereinafter the Fourth Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

Referring to Figure 1 and to independent claims 1 and 19, a method for encouraging users 14 of computer readable content 24 to register is disclosed. Instruction codes 26 are embedded in the computer readable content 24 (page 7, lines 12-13 of Appellant's disclosure). The instruction codes 26 direct a processor circuit 28 to automatically establish a connection to a server 16, when the content 24 is in use by the processor circuit 28, to transmit registration information to the server 16 (page 8, lines 17-21). The instruction code 26 also controls further use of the content 24 by the processor circuit 28 in response to a key received from the server 16 (page 8, lines 21-22). The instruction codes 26 include self-executing application code (page 7, lines 14-16), and the content 24 is non-functional descriptive content (page 6, lines 8-10).

Referring to independent claims 6 and 29, a method for encouraging users 14 of computer readable content 24 to register is disclosed. Computer readable content 24 and

instruction codes 26 embedded in the computer readable content 24 are provided to a user computer 14 (page 7, lines 12-13). The instructions codes 26 direct a processor circuit 28 of the user computer 14 to automatically establish a connection to a server 16, when the content 24 is in use by the user computer 14, to transmit registration information to the server 16 (page 8, lines 17-21). The instruction codes 26 also control further use of the content 24 by the user computer 14 in response to a key received from the server 16 (page 8, lines 21-22). The instruction codes 26 include self-executing application code (page 7, lines 14-16), and the content 24 is non-functional descriptive content (page 6, lines 8-10).

Referring to independent claim 10, a method for encouraging users 14 of computer readable content 24 to register is disclosed. Instruction codes 26 embedded in the computer readable content 24, when the content 24 is in use by a processor circuit 28, are executed to automatically establish a connection to a server 16 to transmit registration information to the server 16 and to control subsequent use of the content 24 by the processor circuit 28 in response to a key received from the server 16 (page 68, lines 17-22). The instructions codes 26 include self-executing application code (page 7, lines 14-16), and the content 24 is non-functional descriptive content (page 6, lines 8-10).

Referring to independent claim 32, a system operable to encourage users 14 of computer readable content 24 to register is disclosed. The system includes a processor circuit 28, a communication interface 29, and a receiver 27. The communications interface 29 communicates with the processor circuit 28 for communicating with a server 16 (page 8, lines 19-20). The receiver 27 receives computer readable content 24 with instruction codes 26 embedded therein (page 8, lines 3-5). The instruction codes 26 cause the processor circuit 28 to automatically cause the communications interface 29 to establish a connection to a server 16 to transmit

registration information to the server 16 (page 8, lines 17-21). The instruction codes 26 also controls subsequent use of the computer readable content 24 by the processor circuit 28, in response to a key received from the server 16 (page 8, liens 21-22). The instructions codes 26 include self-executing application code (page 7, lines 14-16), and the content 24 is non-functional descriptive content (page 6, lines 8-10).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-13, 15, 19-20, 29, and 31-35 were rejected under 35 U.S.C. § 103 for obviousness based upon Snyder et al., U.S. Patent No. 6,070,171 (hereinafter Snyder), in view of Meyer et al., U.S. Patent No. 6,748,362 (hereinafter Meyer);

2. Claims 1-11, 16-20, 29, and 31-35 were rejected under 35 U.S.C. § 103 for obviousness based upon Colvin, U.S. Patent Publication No. 2004/0225900 in view of Meyer;

3. Claims 16 and 17 were rejected under 35 U.S.C. § 103 for obviousness based upon Snyder in view of Myer and Peinado et al., U.S. Patent Publication No. 2003/0078853 (hereinafter Peinado);

4. Claim 18 was rejected under 35 U.S.C. § 103 for obviousness based upon Snyder in view of Peinado and Story et al., U.S. Patent Publication No. 2002/0046181 (hereinafter Story);

5. Claim 21 was rejected under 35 U.S.C. § 103 for obviousness based upon Snyder in view of Bullen, U.S. Patent No. 5,946,677; and

6. Claim 22 was rejected under 35 U.S.C. § 103 for obviousness based upon Snyder in view of Bullen and Tomat et al., U.S. Patent No. 6,784,925 (hereinafter Tomat).

VII. ARGUMENT

THE REJECTION OF CLAIMS 1-13, 15, 19-20, 29, AND 31-35 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON SNYDER IN VIEW OF MEYER

For convenience of the Honorable Board in addressing the rejections, and claims 2-13, 15, 19-20, 29, and 31-35 stand or fall together with independent claim 1.

In the Third Office Action dated January 18, 2006, the Examiner rejected claims 1-15, 19-20, and 29-35 under 35 U.S.C. § 102 for anticipation based upon Snyder. In the Amendment filed July 24, 2006, Appellant amended independent claims 1, 6, 10, 29, and 32 to clarify that the content is non-functional descriptive content. Appellant further referred to page 6 of Appellant's disclosure, which is reproduced below:

> In general, functional descriptive computer readable content may include a program such as Netscape Communicator®, Lotus 1-2-3®, or Microsoft Word®, for example and generally describes any computer readable instructions which cause a processor circuit to carry out some designated functionality. Non-functional descriptive computer readable content may include music, video, or graphic content, for example and generally describes any computer readable content defining information.

Appellant further argued that Appellant's disclosure distinguished between functional descriptive computer readable content (e.g., software programs) and non-functional descriptive computer readable content (i.e., media such as "music, video, or graphic content"). The content described by Snyder is software and thus does not identically disclose the claimed invention within the meaning of 35 U.S.C. § 102.

On page 3 of the Fourth Office Action, the Examiner admitted that Meyer fails to teach that the content is non-functional descriptive content. The Examiner then asserted the following

with regard to the teachings of the secondary reference of Meyers on page 3 of the Fourth Office Action:

> However, Meyer teaches that non-functional descriptive content (col. 4, lines 32-40 & col. 5, line 59 - col. 1 [sic], line 3) can have embedded therein executable code or application-specific data (col. 6, lines 43-55) for the purposes of execution of the code simultaneously with the use of the non-functional descriptive content to control the exact behavior of the execution environment relative to the content while playback is occurring (col. 10, lines 42-53).

With regard to the Examiner's motivation to combine, the Examiner asserted the following on pages 3 and 4 of the Fourth Office Action:

> Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Snyder to embed the Tracker client program and other required data into non-functional descriptive content. One of ordinary skill in the art would have been motivated to perform such a modification to control the exact behavior of the execution environment of the content and track usage of the content, as taught by Meyer (col. 4, lines 32-40, cot. 5, line 59—col. 1, line 3, col. 6, lines 43-55 & col. 10, lines 42-53). (emphasis added)

The only discussion within Myer of controlling the behavior of the execution environment is found in the Examiner's last cited reference, and for ease of reference, column 10, lines 42-53 of Meyer is reproduced below:

> Based on the MIME type of the executable code, an appropriate execution environment is instantiated. In the case of the application/x-shockwave-flash type discussed previously, a reference execution environment is described b Macromedia in the Flash Standards web page.
>
> The execution environment is then invoked to begin execution of the executable code simultaneously with the playback of the audio file. Additional Application Programming Interfaces (APIs) may be defined with reference to the execution environment to control the exact behavior of the execution environment relative to the audio file while playback is occurring.

Upon reviewing this passage, Appellant is unclear as to where Meyer precisely teaches using the imbedded executable code "to control the exact behavior of the execution environment of the content and track usage of the content." Appellant has been unable to find any mention of tracking usage of the content within Meyer. Moreover, referring to the Examiner's cited passage reproduced above, Meyer teaches that the Application Programming Interfaces (APIs) "control the exact behavior of the execution environment." Myer also teaches that an "execution environment is then invoked to begin execution of the execution code." However, Appellant is

unclear as to where Meyer specifically teaches that the executable code stored within the content controls the APIs. Appellant, therefore, respectfully submits that Meyer cannot be relied upon to teach using the executable code within content to control the execution environment of the content, as asserted by the Examiner.

As recognized by the Federal Circuit, "virtually all [inventions] are combinations of old elements."[1] Thus, every element of a claimed invention may often be found in the prior art. However, mere identification in the prior art of each individual element claimed is insufficient to establish the requisite realistic motivation to support the legal conclusion of obviousness under 35 U.S.C. § 103.[2] Moreover, a generalization does not establish the requisite motivation to modify a specific reference in a specific manner to arrive at a specifically claimed invention.[3] Rather, to establish obviousness, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by Appellant.[4] Even *assuming arguendo* that Meyer teaches using the executable code within content to control the execution environment of the content, such a teaching is a generalization that is silent as to how the execution environment of the content is controlled and for what purpose the execution environment is controlled.

Neither of the Examiner's cited references of Snyder and Meyer recognized the problems associated with unauthorized distribution of computer readable content, particularly of non-functional descriptive computer readable content (i.e., media such as "music, video, or graphic

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[1] In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998) (quoting Environmental Designs, Ltd. v. Union Oil, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1993)).
[2] Grain Processing Corp. v. American-Maize Products Co., 840 F.2d 902, 5 USPQ2d 1788 (Fed. Cir. 1988).
[3] In re Deuel, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995).
[4] See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

content"). Instead, Snyder was concerned about copy-tracking distributed software, and Meyer was concerned with embedding data (both functional and non-functional data) in compressed audio, image video and other media files. On the contrary, Appellant has both recognized the problem of unauthorized distribution of computer readable content, particularly of non-functional descriptive computer readable content, and a solution to this problem. It is well settled that the problem addressed and solved by a claimed invention must be given consideration in resolving the ultimate legal conclusion of obviousness under 35 U.S.C. § 103.[5]

Appellant, therefore, submits that Meyers fails to establish the purported motivation for which Meyers is being relied upon. Moreover, the purported motivation by Meyers is a generalization that does not lead to the particularly claimed invention. Additionally, there are indicia of nonobviousness of record which undermine the Examiner's obviousness conclusion. Thus, for the reasons stated above, Appellant respectfully submits that one having ordinary skill in the art would not have arrived at the claimed invention based upon the combination of Snyder and Myer.

THE REJECTION OF CLAIMS 1-11, 16-20, 29, AND 31-35 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON COLVIN IN VIEW OF MEYER

For convenience of the Honorable Board in addressing the rejections, and claims 2-11, 16-20, 29, and 31-15 stand or fall together with independent claim 1.

[5] North American Vaccine, Inc. v. American Cyanamid Co., 7 F.3d 1571, 28 USPQ2d 1333 (Fed. Cir. 1993); Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990); In re Nomiya, 509 F.2d 566, 184 USPQ 607 (CCPA 1975).

Appellant incorporates herein the arguments previously presented above with regard to the Examiner's rejection of Snyder in view of Meyer. Like Snyder, Colvin is also directed to securing software to reduce unauthorized use. However, as noted above, the Examiner's secondary reference of Meyer would not have motivated one having ordinary skill in the art to modify the teachings of Snyder to arrive at the claimed invention. Similarly, one having ordinary skill in the art would not have been motivated to modify the teachings of Colvin to arrive at the claimed invention.

THE REJECTION OF CLAIMS 16 AND 17 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON SNYDER IN VIEW OF MEYER AND PEINADO

For convenience of the Honorable Board in addressing the rejections, and claims 16 and 17 stand or fall together with independent claim 10.

Claims 16 and 17 depend from independent claim 10, and Appellant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 10 under 35 U.S.C. § 103 for obviousness based upon Snyder and Meyer. The Examiner's tertiary reference of Peinado does not cure the argued deficiencies of Snyder and Meyer. Accordingly, the claimed invention would not result from the combination of Snyder, Meyer, and Peinado. Appellant, therefore, respectfully submits that the imposed rejection of claims 16 and 17 under 35 U.S.C. § 103 for obviousness based upon Snyder in view of Meyer and Peinado is not viable.

THE REJECTION OF CLAIM 18 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON SNYDER IN VIEW OF MEYER, PEINADO AND STORY

For convenience of the Honorable Board in addressing the rejections, and claim 18 stands or falls together with independent claim 10.

Claim 18 depends from independent claim 10, and Appellant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 10 under 35 U.S.C. § 103 for obviousness based upon Snyder and Meyer. The Examiner's tertiary references of Peinado and Story do not cure the argued deficiencies of Snyder and Meyer. Accordingly, the claimed invention would not result from the combination of Snyder, Meyer, Peinado, and Story. Appellant, therefore, respectfully submits that the imposed rejection of claim 18 under 35 U.S.C. § 103 for obviousness based upon Snyder in view of Meyer, Peinado, and Story is not viable.

THE REJECTION OF CLAIM 21 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON SNYDER IN VIEW OF MEYER AND BULLEN

For convenience of the Honorable Board in addressing the rejections, and claim 21 stands or falls together with independent claim 10.

Claim 21 depends from independent claim 10, and Appellant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 10 under 35 U.S.C. § 103 for obviousness based upon Snyder and Meyer. The Examiner's tertiary reference of Bullen does not cure the argued deficiencies of Snyder and Meyer. Accordingly, the claimed invention would not result from the combination of Snyder, Meyer, and Bullen. Appellant, therefore,

respectfully submits that the imposed rejection of claim 21 under 35 U.S.C. § 103 for obviousness based upon Snyder in view of Meyer, and Bullen is not viable.

THE REJECTION OF CLAIM 22 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON SNYDER IN VIEW OF MEYER, BULLEN AND TOMAT

For convenience of the Honorable Board in addressing the rejections, and claim 22 stands or falls together with independent claim 10.

Claim 22 depends from independent claim 10, and Appellant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 10 under 35 U.S.C. § 103 for obviousness based upon Snyder and Meyer. The Examiner's tertiary references of Bullen and Tomat do not cure the argued deficiencies of Snyder and Meyer. Accordingly, the claimed invention would not result from the combination of Snyder, Meyer, Bullen, and Tomat. Appellant, therefore, respectfully submits that the imposed rejection of claim 22 under 35 U.S.C. § 103 for obviousness based upon Snyder in view of Meyer, Bullen, and Tomat is not viable.

Conclusion

Based upon the foregoing, Appellant respectfully submits that the Examiner's rejections under 35 U.S.C. §§ 102, 103 based upon the applied prior art are not viable. Appellant, therefore, respectfully solicits the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 102, 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: February 27, 2007

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. A method for encouraging users of computer readable content to register, the method comprising:

embedding, in said computer readable content, instruction codes

operable to direct a processor circuit to automatically establish a connection to a server, when said content is in use by said processor circuit, to transmit registration information to said server, and

operable to control further use of said content by said processor circuit in response to a key received from said server, wherein

the instruction codes include self-executing application code, and

said content is non-functional descriptive content.

2. The method of claim 1 further comprising storing said computer readable content and said embedded instruction codes on a portable memory medium.

3. The method of claim 1 further comprising providing said computer readable content and said embedded instruction codes for use by a user computer.

4. The method of claim 1 wherein embedding comprises embedding a self executing applet in said computer readable content.

5. The method of claim 4 further comprising producing said applet such that said applet contains said instruction codes.

6. A method for encouraging users of computer readable content to register, the method comprising:

providing to a user computer said computer readable content and instruction codes embedded in said computer readable content, said instruction codes being

operable to direct a processor circuit of said user computer to automatically establish a connection to a server, when said content is in use by said user computer, to transmit registration information to said server, and

operable to control further use of said content by said user computer in response to a key received from said server, wherein

the instruction codes include self-executing application code, and

said content is non-functional descriptive content.

7. The method of claim 6 wherein providing comprises transmitting said computer readable content and said embedded instruction codes to said user computer.

8. The method of claim 7 wherein transmitting comprises transmitting said computer readable content and said embedded instruction codes on a communications network.

9. The method of claim 7 wherein transmitting comprises providing a computer readable medium to a user, said computer readable medium having stored thereon said content and said embedded instruction codes.

10. A method for encouraging users of computer readable content to register, the method comprising:

executing instruction codes embedded in said computer readable content, when said content is in use by a processor circuit, to automatically establish a connection to a server to transmit registration information to said server and to control subsequent use of said content by said processor circuit in response to a key received from said server, wherein

the instructions codes include self-executing application code, and

said content is non-functional descriptive content.

11. The method of claim 10 wherein executing comprises causing said instruction codes to be executed when access is made to said content by said processor circuit.

12. The method of claim 10 wherein executing comprises producing a measure of use of said content by said processor circuit.

13. The method of claim 12 wherein producing said measure of use of said content comprises determining a number of times said content is accessed by said processor circuit.

15. The method of claim 12 wherein producing said measure of use comprises determining document usage by function descriptive content in said computer readable content.

16. The method of claim 12 further comprising establishing said connection to said server when said measure of use exceeds a threshold value.

17. The method of claim 16 wherein establishing said connection comprises establishing an internet protocol connection with said server.

18. The method of claim 17 further comprising launching a browse session with a uniform resource locator pointing to a user registration page for permitting a user to enter registration information.

19. The method of claim 10 wherein controlling subsequent use of said content comprises enabling subsequent use of said content when said key is received from said server.

20. The method of claim 10 wherein controlling subsequent use of said content comprises disabling further use of said content when no key is received from said server.

21. The method of claim 20 further comprising deleting files produced by functional descriptive content in said computer readable content.

22. The method of claim 21 further comprising warning a user of said processor circuit that files are about to be deleted.

29. A computer readable medium on which is stored computer readable content and instruction codes embedded in said computer readable content, said instruction codes being

operable to direct a processor circuit to automatically establish a connection to a server, when said content is in use by the processor circuit, to transmit registration information to the server, and

operable to control further use of the content by the processor circuit in response to a key received from the server, wherein

the instructions codes include self-executing application code, and

said content is non-functional descriptive content.

31. The computer readable medium of claim 29 wherein said instruction codes are provided in a self executing applet.

32. A system operable to encourage users of computer readable content to register, the system comprising:

a) a processor circuit;

b) a communications interface in communication with said processor circuit for communicating with a server; and

c) a receiver for receiving computer readable content with instruction codes embedded therein, said instruction codes being operable

to cause said processor circuit to automatically cause said communications interface to establish a connection to a server to transmit registration information to the server, and

to control subsequent use of said computer readable content by said processor circuit, in response to a key received from the server, wherein

the instructions codes include self-executing application code, and

said content is non-functional descriptive content.

33. The system of claim 32 wherein said receiver includes a media reader.

34. The system of claim 32 wherein said communications interface is operable to establish communications on a network.

35. The system of claim 32 wherein said processor circuit is part of a personal computer.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellant in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellant is unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.